

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant: Ernest A. Voisin

Serial No.: 09/121,725

Group Art Unit: 1761

Filed: July 24, 1998

Examiner: Drew Becker

For: Process of Elimination of Bacteria in
Shellfish, of Shucking Shellfish and
An Apparatus Therefor

Date: December 21, 2004

Mail Stop: Reply Brief
To the Honorable Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF UNDER 37 C.F.R. 1.193(b)(1)

Sir:

This is appellant's Reply Brief filed in response to Examiner's Answer mailed on October 21, 2004.

Examiner contends that the appellant did not distinctly argue separate patentability of the claims. The appellant respectfully brings attention of the Board to the Brief filed on August 30, 2004, and more particularly to pages 3-5 of the Brief devoted to the detailed reasoning of separate patentability of each claim on appeal.

It is well established that in order to anticipate a claim and render it invalid, a single prior art reference must expressly or inherently disclose each and every element set forth in the claim. See, e.g. Karsten Mfg. Corp. v. Cleveland Golf. Co., 242 F.3d 1376, 58 U.S.P.Q. 2d (BNA) 1286 (Fed. Cir 2001); In re Schreiber, 128 F.3d 1473, 44 U.S.P.Q.2d (BNA) 1429 (Fed. Cir. 1997); Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 231 U.S.P.Q. (BNA) 81 (Fed. Cir. 1986). To anticipate, the prior art reference must also be enabling. That is, the reference must place the allegedly disclosed subject matter in the

possession of the public. See, e.g., Helifix, Ltd. V. Blok-Lol. Ltd., 208 F.3d 1339, 54 U.S.P.Q. 2d 1299 (Fed. Cir. 2000) (citing In re Paulsen, 30 F.3d 1475, 31 U.S.P.Q.2d (BNA) 1671 (Fed. Cir. 1994)); Akzo N.V. v. United States Int'l Trade Comm'n, 808 F.2d 1471, 1 U.S.P.Q.2d (BNA) 1241 (Fed. Cir. 1986). It is impermissible to combine prior art references to build an anticipation rejection. In re Donohue, 766 F.2d 531, 226 U.S.P.Q. (BNA) 619 (Fed. Cir. 1985). Instead, an anticipation rejection requires a showing that each limitation of a claim must be found in a single reference, practice, or device. *Id.*

The appellant is cognizant of the fact that a recent series of the Federal Circuit cases have considerably expanded the concept of anticipation. Anticipation does not require that the prior art reference, device or disclosure "teach" the same invention as taught in the patent. However, there is a requirement that the claim in question read on a single piece of prior art. Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 218 U.S.P.Q. (BNA) 781 (Fed. Cir. 1983) (overruled on other grounds by, SRI Intern v. Matsushita Elec. Corp. of America, 775 F.2d 1102, 227 U.S.P.Q. (BNA) 577 (Fed. Cir. 1985). However, if a reference is not enabling (See, e.g., In re Paulsen, 30 F.3d 1475, 31 U.S.P.Q.2d (BNA) 1671 (Fed. Cir. 1994) (Sec. 102(b)), or if it does not describe the claimed invention in sufficient detail to put one of ordinary skill in the art in possession of the invention, that reference is not an anticipation. ATD Corp. v. Lydall, Inc., 159 F.3d 534, 48 U.S.P.Q.2d (BNA) 1321 (Fed. Cir. 1998). See, also Glaxo, Inc. v. Novopharm, Ltd., 52 F.3d 1043, 34 U.S.P.Q.2d (BNA) 1565 (Fed. Cir. 1995), *reh'g denied*, en banc suggestion declined, (June 21, 1995) (finding no inherent disclosure of the invention where experimentation revealed that the prior art did not consistently yield the claimed invention

In Toro Co., v. Deere & Co., 355 F.3d 1313, 69 U.S.P.Q.2d 1584 (Fed. Cir. 2004), the Federal Circuit Court stated, “The fact that a characteristic is a necessary feature or result of a prior-art embodiment (that is itself sufficiently described and enabled) is enough for inherent anticipation, even if that fact was unknown at the time of the prior invention,” citing Atlas Powder Co. v. Ireco, Inc., 190 F.3d 1342 (Fed. Cir. 1999). It follows then, that a non-enabling embodiment(s) or prior art cannot be enough to establish inherent anticipation.

It is axiomatic that “to be enabling, the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without 'undue experimentation,'" In re Wright, 999 F.2d 1557, 1561, 27 U.S.P.Q. 1510,1513 (Fed. Cir. 1993). With regard to the cited Japanese application No. 4356156A, the appellant had to perform numerous experiments (well beyond the proverbial “undue experimentation” standard) in an effort to reproduce the results of oyster shucking using the working examples described in that application. The results of the “undue experimentation” are reflected in the declarations of record in this Appeal.

Examiner contends that the declarations of the inventor discussing these numerous experiments are “not relevant to the instant claims.” If these experiments are not relevant to the requirement of enablement annunciated by the Federal Circuit, then the entire rejection of the claims based on “inherent anticipation” asserted by the Examiner must fail.

With regards to the temperature factor, Examiner appears to have misunderstood appellant’s position. The reason for providing the additional temperature factor during the above-mentioned experiments was to stress the main point: that the cited reference discloses pressure and time values that do not produce the result asserted in the working examples of cited prior art. The declarations assert that the appellant followed the method steps in these

working examples and the experiments showed the working examples did not work - they did not produce shucking of oysters. It is only after the water temperature was elevated that the pressure and time values could be experimentally adjusted to produce the result that the cited reference claimed to have achieved.

MPEP 716.07 states: “Since every patent is presumed valid (35 U.S.C. 282), and since that presumption includes the presumption of operability (*Metropolitan Eng. Co. v. Coe*, 78 F.2d 199, 25 USPQ 216 (D.C.Cir. 1935), examiners should not express any opinion on the operability of a patent.” In the present case, Examiner cited a Japanese application, to which the presumption of operability does not apply. Mistakenly, Examiner equates disclosure of an application with the presumption of operability afforded only to issued patent, when he states that that the “[A]ppellant seems to ignore the fact that JP 4356156A teaches and successfully uses. . . .” Appellant challenged operability of the invention disclosed in the cited reference, submitting numerous declarations from persons skilled in the art, inventor’s declarations and an additional printed publication (JP 2000157157A), all of which attest to the non-operability of the process of oyster shucking as disclosed in the cited application JP 4356156A.

The same insufficiency of description and operability required by the holding in Toro Co., v. Deere & Co , applies to the page of Cheftel’s book. The page, heavily relied upon by Examiner as allegedly demonstrating “common knowledge” lacks any description that could be used by the public without “undue experimentation” in order to eliminate naturally-occurring pathogenic bacteria.

The requirement of enablement and operability is also important for the finding of obviousness. As the Federal Circuit stated in Motorola, Inc. v. Interdigital Technology Corp.,

121 F.3d 1461, 43 U.S.P.Q.2d (BNA) 1481 (Fed. Cir. 1997) and in Beckman Instruments, Inc. v. LKB Produkter AB, 892 F.2d 1547, 13 U.S.P.Q. 2d (BNA) 1301 (Fed. Cir. 1989), "In order to render a claimed apparatus or method obvious, the prior art must enable one skilled in the art to make and use the apparatus or method."

Here, the prior art does not place in the public domain sufficient information on how to perform the process of pressurizing oysters in order to shuck the oysters. It is only after numerous tests and experiments ("undue experimentation") that one might be able to achieve the result. However, the working examples in the Japanese application, which are supposed to provide the shortcut to achieve the claimed result, proved insufficient by the tests conducted by the instant inventor.

In conclusion, the appellant has effectively met the burden of proof required to traverse Examiner's rejection based on Sections 102 and 103. Once the appellant met the burden of proof, the burden to contest the appellant's proof shifted back to the Patent Office. Instead of supplying the missing pieces of the puzzle, Examiner continued his rejection based on the same grounds, using the same "prior art." For these reasons, appellant respectfully requests reconsideration of the rejection of the claims and allowance thereof.

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P.O. Box 1450
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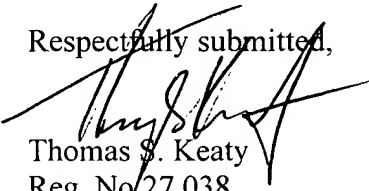
Debra Hom

Debra Hom

12/21/04

Date

Respectfully submitted,


Thomas S. Keaty
Reg. No. 27,038
Keaty Professional Law Corporation
2140 World Trade Center
2 Canal Street
New Orleans, LA 70130
(504) 524-2100